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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,651	08/15/2001	Takayuki Narita	81868.0032	2848

26021 7590 10/02/2003  
HOGAN & HARTSON L.L.P.  
500 S. GRAND AVENUE  
SUITE 1900  
LOS ANGELES, CA 90071-2611

EXAMINER

SICONOLFI, ROBERT

ART UNIT	PAPER NUMBER
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3683

DATE MAILED: 10/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/931,651

Applicant(s)

NARITA ET AL.

Examin r

Robert A. Siconolfi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4,6 and 8-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6 and 8-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/8/03 has been entered.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-4 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not disclose the lubrication containing cupric benzotriazole. The only mention in the specification of cupric benzotriazole is in the anti-rust film.

NOTE: In order to advance prosecution, the examiner has made the following rejection ignoring the contested limitation.

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***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

NOTE: The applicant has amended the claims to include a process step. Product by process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Therefore, the examiner is required only to show that the product is obvious. Please see MPEP 2113.

5. Claims 1-4, and 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukutani et al (U. S. Patent no. 5,998,898) in view of Brusic et al (U. S. Patent no. 5,316,573) and Pavilon et al (U. S. Patent no. 5,308,521).

Fukutani et al discloses:

See figures shaft 12, copper sleeve/ cylindrical member 21 with bearing gaps containing lubricating fluid (see figure 2)

Fukutani et al does not disclose coating the copper cylindrical member with Cupric Benzotriazole. Brusic et al teaches coating copper members for corrosion protection (see column 2 lines 3-5). It would have been obvious to one of ordinary skill in the art at the time the invention was made to coat the copper cylindrical member with Cupric

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Benzotriazole as taught by Brusic et al in the bearing of Fukutani et al in order to protect the device.

Regarding claim 4, the thickness of the antirust coating is a design choice based on wear, performance, and costs of the device. It would have been obvious to one of ordinary skill in the art at the time the invention was made to choose any thickness of anti rust coating in order to optimize the bearing based on chosen design criteria.

Fukutani, as modified, does not disclose adding benzotriazole into the lubrication fluid. Pavilon et al teaches adding benzotriazole into the lubrication fluid to protect copper bearing parts. It would have been obvious to one of ordinary skill in the art at the time the invention was made to add benzotriazole to the lubricating fluid as taught by Pavilon et al in the bearing of Fukutani, as modified, in order to further protect the bearing and thus increase durability.

Regarding claim 8, see column 2 lines 28-41

NOTE: In order to expedite prosecution, since if a process can be shown to be critical and therefore receive patentable weight, the examiner makes the following parallel rejection which shows that the process claimed by the applicant is old and well known.

6. Claims 1-4 ,6 and 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukutani et al (U. S. Patent no. 5,998,898) in view of Hobbins et al (U. S. Patent no. 4,395,294) and Pavilon et al (U. S. Patent no. 5,308,521).

Fukutani et al discloses:

See figures shaft 12, copper sleeve/ cylindrical member 21 with bearing gaps containing lubricating fluid (see figure 2)

Fukutani et al does not disclose coating the copper cylindrical member with Cupric Benzotriazole. Hobbins et al teaches coating copper members for corrosion protection by reacting the copper with benzotriazole (see column 2 lines 11-19). It would have been obvious to one of ordinary skill in the art at the time the invention was made to coat the copper cylindrical member with Cupric Benzotriazole by reacting the copper with benzotriazole as taught by Hobbins et al in the bearing of Fukutani et al in order to protect the device.

Regarding claim 4, the thickness of the antirust coating is a design choice based on wear, performance, and costs of the device. It would have been obvious to one of ordinary skill in the art at the time the invention was made to choose any thickness of anti rust coating in order to optimize the bearing based on chosen design criteria.

Fukutani, as modified, does not disclose adding benzotriazole into the lubrication fluid. Pavilon et al teaches adding benzotriazole into the lubrication fluid to protect copper bearing parts. It would have been obvious to one of ordinary skill in the art at the time the invention was made to add benzotriazole to the lubricating fluid as taught by Pavilon et al in the bearing of Fukutani, as modified, in order to further protect the bearing and thus increase durability.


Regarding claim 8, see column 2 lines 28-41

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert A. Siconolfi whose telephone number is 703-305-0580. The examiner can normally be reached on M-F 10 am-3 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Lavinder can be reached on (703) 308-3421. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

  
Robert A. Siconolfi  
Examiner  
Art Unit 3683

RS